

D-1077+18

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
Jay Paul Drummond, et al.)	
)	
Application No.: 09/639,310)	Art Unit 3624
)	
Confirmation No.: 9530)	
)	
Filed: August 14, 2000)	Patent Examiner
)	Debra F. Charles
)	
Title: Automated Banking Machine)	
Customer Profile Method)	

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Commissioner for Patents
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**THIRD SUPPLEMENTAL APPEAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby respectfully request reinstatement of their appeal. The Appellants hereby submit their 3rd Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This 4th Appeal Brief is in response to the Office Action dated June 21, 2005.

(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is
Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

Other applications (09/193,564; 09/193,646; 09/193,647; 09/193,662; 09/193,787; 09/193,791; 09/578,312) having been assigned appeal numbers claim priority to the parent application (09/077,337). It is believed that these other appeals do not pertain to the claimed subject matter. However, it is respectfully requested that the Board make its own determination regarding the pertinence of these other applications. The Board is also requested to check (update) the status of the above-mentioned applications and other applications that may claim priority to the parent application with regard to appeal.

Appellants, Appellants' legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)

STATUS OF CLAIMS

Claims 1-28 are pending in the Application.

Claims rejected: 1-28

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants continue to appeal the rejections of claims 1-28, inclusive. The current rejections were the only rejections present in the non-final Office Action ("Action") dated June 21, 2005.

(iv)

STATUS OF AMENDMENTS

The Action dated June 21, 2005, which again reopened prosecution, followed a 3rd Appeal Brief (which followed submission of the 1st and 2nd Appeal Briefs). Appellants again respectfully request reinstatement of their appeal.

The Action dated June 21, 2005 was not made final. Thus, no amendments to the claims were requested to be admitted after a final rejection.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

With respect to independent claim 1

An exemplary form of the invention is directed to a method of operating an automated transaction machine (e.g., ATM 12; Figures 1-3). The method includes reading customer identification information from a card with a card reading device (e.g., 38; Figure 2; page 14, lines 20-22; page 85, lines 14-17). The method further includes accessing at least one customer profile value (e.g., 419, 421, 425, 426) from at least one data store (e.g., 266, 608, 610, 612; Figures 43 and 55), responsive to the customer identification information (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16). The method additionally includes generating at least one web page responsive to the at least one customer profile value (e.g., page 106, line 21 to page 107, line 1; page 35, lines 6-12; page 36, lines 14-16). The method also includes displaying (e.g., 30) the at least one web page at the machine through operation of a browser (e.g., 76), wherein the at least one web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine (e.g., page 106, line 21 to page 107, line 1; page 35, lines 18-21; page 37, lines 3-16). Also note page 25, line 11 to page 37, line 16, and pages 106-109.

With respect to independent claim 9

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes reading an account number from a card with a card reading device (e.g., 38; Figure 2; page 14, lines 20-22; page 85, lines 14-17) of an automated transaction machine (e.g., ATM 12; Figures 1-3). The method further includes accessing a plurality of customer profile values that correspond to the account number (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16). The method additionally includes displaying (e.g., 30) a web page in a browser (e.g., 76) with the automated transaction machine (e.g., 12), wherein the web page includes a plurality of selectable options for performing a transaction with the automated transaction machine (e.g., page 106, line 21 to page 107, line 1; page 35, lines 18-21; page 37, lines 3-16), wherein at least one of the selectable options is produced responsive to at least one of the accessed customer profile values (e.g., page 106, line 21 to page 107, line 1; page 35, lines 6-12; page 36, lines 14-16). The method also includes receiving an input that corresponds to a selected one of the selectable options with an input device (e.g., page 106, line 21 to page 107, line 3; page 37, lines 1-16). The method moreover includes performing the transaction with the automated transaction machine responsive to the selected one of the selectable options (e.g., page 106, line 21 to page 107, line 3).

With respect to independent claim 13

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes receiving at least one customer identification value (e.g., page 107, lines 17-20) with an automated transaction machine (e.g., ATM 12; Figures 1-3). The method further includes accessing a customer profile from a data store (e.g., 266, 608, 610, 612; Figures 43 and 55), wherein the customer profile corresponds to the customer identification value (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16), wherein the customer profile includes a customer type value (e.g., 419) that differentiates between classes of customers with regard to operations available with the automated transaction machine (e.g., page 106, lines 5-8). The method additionally includes displaying (e.g., 30) a web page in a browser (e.g., 76) of the automated transaction machine (e.g., 12), wherein the web page is loaded responsive to the customer type value (e.g., page 106, line 21 to page 107, line 1).

With respect to independent claim 21

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes receiving customer identity information at an ATM (e.g., 12; Figure 2; page 14, lines 20-22; page 85, lines 14-17), wherein the ATM (12) includes a cash dispenser (42; Figure 2) operative to dispense cash. The method further includes accessing a customer profile responsive to the customer identity information (e.g., page 107, lines 17-20; page 109, lines 14-15; page 95, lines 11-14; page 35, lines 6-16). The method also includes retrieving marketing information from the

customer profile (e.g., page 108, lines 1-4). The method additionally includes selecting a targeted advertisement responsive to the marketing information (e.g., page 108, lines 1-4; page 30, lines 1-3; page 38, lines 19-22). The method further includes displaying (e.g., 30) a web page in a browser (e.g., 76) of the ATM (12), wherein the web page includes the targeted advertisement (e.g., page 108, lines 1-4).

With respect to independent claim 25

Another exemplary form of the invention is directed to a method. Support in the disclosure for similar claim language has previously been provided. The method includes receiving customer identification information with an ATM (e.g., 12; Figure 2; page 14, lines 20-22; page 85, lines 14-17), wherein the ATM (12) includes at least one banking transaction function device (e.g., 36), wherein the at least one banking transaction function device includes a currency dispenser (42; Figure 2) operative to dispense currency. The method additionally includes displaying (e.g., 30) at least one web page at the ATM (12) through operation of at least one browser (e.g., 76), wherein the at least one web page respectively corresponds to the received customer identification information (e.g., page 107, lines 17-22; page 106, line 21 to page 107, line 1), wherein the at least one web page includes a plurality of banking transaction selections associated with performing banking transactions with the ATM (e.g., page 106, line 21 to page 107, line 1; page 35, lines 18-21; page 37, lines 3-16), and wherein at least one of the selections includes a currency withdrawal request (e.g., page 107, lines 13-16; page 37, lines 3-9).

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

- 1). Whether claims 1-3, 9-10, 13, 21, and 25-28 are unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, and Simmons.
That is, Wagner (U.S. 5,742,845), Dasan (U.S. 5,761,662), Lawlor, et al. (US 5,220,501) ("Lawlor"), and Simmons (US 5,974,451).
- 2). Whether claims 5, 8, 12, 20, and 24 are unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Deaton and Jheeta.
That is, Deaton, et al. (US 5,642,485) ("Deaton") and Jheeta (US 5,619,558).
- 3). Whether claim 22 is unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Jheeta.
- 4). Whether claim 4 is unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Akiyama, et al. (US 5,539,825) ("Akiyama").

- 5). Whether claims 6-7, 11, 17, and 23 are unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Patterson, et al. (US 5,915,246) ("Patterson").
- 6). Whether claims 14-15 and 18 are unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Clausing (US 4,091,448).
- 7). Whether claim 16 is unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Patterson.
- 8). Whether claim 19 is unpatentable pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Martin, Jr. et al. (US 6,304,860) ("Martin").

(vii)

ARGUMENT

The Applicable Legal Standards for 35 U.S.C. § 103 (a) Rejections

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Patentability determination must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action requiring appeal does not meet these burdens.

The 35 U.S.C. § 103(a) rejections are legally improper

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. Nor do the references teach or suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

The only suggestion for the recited features and relationships is found in Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Office has not established a *prima facie* showing of obviousness. Additionally, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be withdrawn.

Wagner (U.S. Patent No. 5,742,845)

The disclosure of Wagner (U.S. Patent No. 5,742,845) is silent as to the exact details concerning complete and enabling operation of the system. Therefore, the description of any portion of Wagner herein or any comments directed thereto shall not be construed as an agreement or an admission by Appellants that Wagner's system is capable of achieving any of Appellants recited features.

Wagner's is directed to providing a more secure consumer-initiated home-based payment transaction (col. 5, lines 12-13 and 19-22; col. 6, lines 16-20; col. 7, lines 10-11). Wagner's goal is to permit consumers remote from a merchant to initiate transactions and present payment in a secure manner (col. 6, lines 23-27, 34-39, 41-46, and 49-52). The system permits both use of non-confidential Internet communication (col. 7, lines 16-18) and use of confidential (PSTN) communication for the payment (col. 6, lines 8-16; col. 7, lines 15-25; col. 11, lines 58-67; col. 18, lines 26-36 and 56-64). Wagner's newly created extended Internet protocol (using a PAYMENT command) enables use of a separate non-Internet, telephone based secure communications link (e.g., VISA protocol) for transmitting confidential payment (credit card account) information. The PAYMENT command implemented in Wagner's special Internet protocol (col. 6, lines 54-58; col. 11, lines 58-61) causes the connection of a secure (non-Internet) communications link between a non-standard I/O device and a transaction processing center (422) to permit secure payment. Wagner distinguishes a non-standard I/O device from an ATM.

Figure 13A of Wagner shows an example of communication paths available for a non-standard I/O device (420) implementing Wagner's invention. The example is described at col.

18, lines 7-64. Three party (consumer, merchant, and transaction processing center) communication can be used to carry out a transaction. A non-standard I/O device (420; Figure 13A) and server (12; Figures 1 and 13A) communicate over the Internet using Wagner's special extended protocol (col. 18, lines 11-12). When payment is to be made by the consumer, the system enables a command from the server (12) to cause a separate telephone connection to be made so as to provide a more secure communication connection between the non-standard I/O device (420) and a transaction processing center (422; Figure 13A) (col. 18, lines 15-17). To open the more secure telephone connection, Wagner's special PAYMENT command is used. The PAYMENT command causes the non-standard I/O device (420) to suspend (col. 18, line 43) its Internet communication path (426; Figure 13A) and activate an application (e.g., a bank card authorization application) that uses a standard analog signal Public Switched Telephone Network (PSTN) communication path (424; Figure 13A). The non-standard I/O device (420) which is now disconnected from the Internet, can then safely pass the consumer's sensitive credit card account information to the remote transaction processing center (422) via the more secure (PSTN) communication path (424). Thus, Wagner undertook to combine non-confidential communication advantages of the Internet with a more secure conventional telephone communication (PSTN) link (col. 7, lines 20-25).

Note regarding reference claim language

For reasons of brevity, claim language may be referred to herein in a shortened version. For example, language such as "at least one" may be referred to as "a". Any generalized statement herein is not to limit any of the mentioned claims in any manner. Please refer to the claim for the exact claim language.

**The Claims Are Not Obvious Over
Wagner in view of Dasan, Lawlor, and Simmons**

Claims 1-3, 9-10, 13, 21, and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, and Simmons.

The Action (at page 4, first paragraph) admits that Wagner does not teach or suggest "the features of customer identification and, accessing at least one customer profile value from at least one data store, accessing a customer profile responsive to the customer identity information, wherein the customer profile corresponds to the customer type value, wherein a customer type value differentiates between classes of customers; responsive to the customer identification information, and displaying the at least one web page at the machine through operation of a browser."

The Action relies on Dasan for allegedly teaching "a user profile displaying on a web page whereby the user profile describes the customer preferences and identifies the type of customer via the client computer which provides the identification of a user-defined profile."

The Action (at page 5) admits that Wagner and Dasan do not teach or suggest "retrieving marketing information from the customer profile; selecting a targeted advertisement responsive to the marketing information."

The Action relies on Lawlor for allegedly teaching "marketing information reflecting a customer profile built into the system."

The Action (at page 6) admits that Wagner, Dasan, and Lawlor do not teach or suggest "the web page includes the targeted advertisement."

The Action further relies on Simmons for allegedly teaching "targeted advertisements sent to the customer via a network web-based system."

The Appellants respectfully traverse the rejections. The Office has not explicitly read the claimed invention on the applied prior art. The Action fails to provide a claim by claim analysis of how the applied prior art teaches or suggests the claimed invention. Thus, how the Office reached its conclusions is not of record.

A proper *Graham v. John Deere* analysis has not been conducted

The Action fails to ascertain the differences between the applied prior art and the claims in issue. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The Action is silent as to the "differences" between the combination of Wagner and Dasan and *all* the claims at issue. That is, the Action fails to point out what the references (e.g., Wagner/Dasan) do *not* teach with regard to all the claims.

For example, what features does the Office rely on in Lawlor and Simmons that are absent from Wagner/Dasan with regard to claim 1? The indicated reliance upon Lawlor for "marketing information" and Simmons for "targeted advertisements" is not pertinent to claim 1. Actually, "marketing information" and "targeted advertisement" only appear in claims 21-24. Therefore, as best understood (in the absence of any contrary evidence), Lawlor and Simmons only apply to claims 21-24.

Because the Action has not properly conducted a *Graham v. John Deere* analysis, and therefore has not met the required criteria for a *prima facie* case of obviousness, it follows that no *prima facie* case of obviousness has been established. That is, the Action procedurally fails to

establish a *prima facie* case of obviousness. If the Office has not established a *prima facie* case of obviousness, which is the current situation, then the Appellants have no obligation to submit any evidence regarding nonobviousness. MPEP § 2142.

The Appellants respectfully decline to speculate on any other intended (and not of record) application of Lawlor and Simmons. Appellants are not required to prove patentability. Contrarily, it is the Office which must establish a *prima facie* case of obviousness *under the law*. Absent a *prima facie* showing of obviousness, which is the current situation, the Office is legally required to issue a patent. For these reasons, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejections should be withdrawn.

Appellants further respectfully request that, in view of this *4th Appeal Brief*, the Board not grant the Office any further attempts to meet its burden via a remand. If a *prima facie* case of unpatentability was not already established by the Office at the time of this 4th Appeal Brief, then the rejections should be reversed. Following reversal, when jurisdiction is returned to the examining group, the Office still has ample opportunity to take further action. Even so, Appellants acknowledge that it is the sole discretion of the Board to determine the best course of action.

Appellants below provide a response to the claim rejections (as best understood) in spite of the Office's improper analysis. However, Appellants reserve all rights to amend their arguments, including the filing of yet another Supplemental Appeal Brief, because of the improper analysis.

Claim 1

The Action (at page 4) admits that Wagner does not teach or suggest the step of "accessing at least one customer profile value from at least one data store, . . . responsive to the customer identification information" (step b). That is, the Action admits that Wagner does not teach or suggest the recited customer profile, data store, or accessing a customer profile responsive to customer identification information (read from a card). The Action admits that Wagner does not teach or suggest step (b).

The Action (at page 4) further admits that Wagner also does not teach or suggest the step of "displaying the at least one web page at the machine through operation of a browser" (step d). That is, the Action also admits that Wagner does not teach or suggest step (d).

Appellants respectfully submit that Wagner lacks more of the recited steps than the Action admits. For example, the Action (on page 8) *admits* that "Wagner, Dasan, Lawlor et al., Simmons and Deaton et al. disclose(s) the claimed invention except *customer identification*." It further follows that Wagner cannot teach or suggest recited step (a) of claim 1.

Nor does Wagner teach or suggest recited step (c). Step (c) recites "generating at least one web page *responsive to the at least one customer profile value*." Wagner at the relied upon sections (Abstract; claims 1-3; col. 3, lines 15-40; and col. 19, lines 30-67) does not teach or suggest recited step (c). Where does Wagner even mention a "customer profile value"?

Furthermore, the "customer profile value" of step (c) refers back to step (b). If Wagner does not teach or suggest step (b), which the Action admits, then it follows that Wagner cannot teach or suggest step (c). Accordingly, as best understood, the Action (on page 4) apparently

alleges that Wagner teaches only a portion of step (c), namely "generating at least one web page."

Regardless, Wagner does not teach or suggest the entire recited step (c).

Returning to step (d), step (d) refers back to *the* "at least one web page" of step (c).

Appellants have shown that Wagner does not teach or suggest step (c). If Wagner does not teach or suggest step (c), then it follows that Wagner cannot teach or suggest step (d) which refers back to step (c). As previously mentioned, the Action admits that Wagner does not teach or suggest "displaying *the* at least one web page at the machine through operation of a browser." In other words, the Action admits that Wagner does not teach or suggest displaying (at an automated transaction machine) a web page (through operation of a browser) that was generated in response to a customer profile value that was accessed from a data store in response to customer identification information read from a card with a card reading device. Appellants agree with the Action's admission that Wagner does not teach or suggest step (d).

The Appellants respectfully submit that there is also no evidence of record that Wagner relies on, needs, or even mentions a *browser*. Likewise, where does Wagner even mention a *web page*? Again, Wagner does not teach or suggest step (d). Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner to have produced the recited step (d). The rejection is based purely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra.

The Appellants respectfully submit that Wagner further does not teach or suggest, the part of step (d) that recites that "the at least one web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine." Where does

Wagner teach or suggest a relationship between a web page and the performing of automated transaction machine transactions? Where does Wagner teach or suggest displaying a web page to enable selection of a machine transaction to be performed? The Action (on page 4) incorrectly relies on Wagner at col. 1, lines 30-67 and Figures 12-24B for teaching this part of step (d). These relied upon sections of Wagner do not provide the alleged teaching. Furthermore, the Action itself (on page 14, lines 3-5) *admits* that Wagner does not teach or suggest displaying a web page "including a plurality of selectable transaction options for performing transactions with the automated transaction machine." Again, Wagner does not teach or suggest step (d).

As best understood, the Action (e.g., page 3, last paragraph to page 4, line 2) relies on an ATM in Wagner as being the recited automated transaction machine. However, an ATM is *not* a part of Wagner's invention and thus does not include the features attributed thereto by the Office. Wagner is directed to home-based transactions, which teaches away from using an ATM in Wagner's invention. Some would argue that home-based transactions are the antithesis of ATM transactions. Nor does Wagner discuss ATM components or operation. Wagner merely mentions "ATM" at col. 1, lines 26, 29, 47, 60, 65; col. 2, line 1; and col. 4, line 24. That is, ATMs are mentioned only in the prior art Background section of Wagner. (The term "ATM" mentioned at col. 12, line 19 is a typographical error, as it should read "AMT", as evidenced by Figure 14; col. 13, line 59; and col. 15, line 60). Wagner distinguishes a non-standard I/O device (which is an integral part of Wagner's invention) from an ATM on many occasions, e.g., because of the different connection interface used (col. 4, lines 4-7; col. 3, lines 62-67); because ATMs (unlike non-standard I/O devices) have long been connected directly to proprietary networks (col. 5, lines 43-47; col. 6, lines 16-20); and because of Wagner's acknowledged difference

therebetween by use of their different names. Thus, Wagner further does not teach or suggest the recited method.

Appellants have shown (by either admitted or noted deficiencies) that the relied upon primary reference (Wagner) does not teach or suggest *any* of the recited steps. As Wagner does not teach or suggest the features and relationships relied upon to sustain the rejection (which the Action itself admits), the rejection is improper and should be withdrawn.

Appellants will now show that the relied upon secondary reference (Dasan) cannot alleviate the deficiencies of Wagner as it does not teach or suggest the recited features, relationships, and steps which are not found in Wagner. As previously discussed, until the Office reveals on the record the applicability (if any) of Lawlor and Simmons to claim 1, these references are disqualified from the rejection of claim 1. That is, the record (as best understood) points to Lawlor and Simmons as having been mistakenly placed in the rejection claim 1.

Dasan is non analogous art. Dasan is directed to creating a newspaper (col. 2, lines 41-42; col. 1, lines 13-15). One skilled in the art of automated transaction machine (e.g., ATM) transactions would recognize that it would not have been obvious (nor tolerated by other customers waiting in line, for example) to modify Wagner (if somehow even possible) to permit creating and reading a newspaper at an ATM, as alleged by the Office. Wagner desires securing consumer-initiated transactions, not creating a newspaper. The alleged modification to Wagner with the teaching of Dasan would destroy the disclosed utility and advantage of Wagner. An obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Dasan (like Wagner, as admitted by the Office) does not teach or suggest step (a). Dasan does not teach or suggest reading customer identification information from a card with a card reading device. Dasan doesn't even mention a card or a card reader. Additionally, the Action (on page 8) *admits* that "Wagner, Dasan, Lawlor et al., Simmons and Deaton et al. disclose(s) the claimed invention except *customer identification*." It follows that the relied upon Wagner and Dasan, taken alone or in combination, do not teach or suggest step (a) of claim 1. It further follows that the Office has not established a *prima facie* case of obviousness with regard to the recited step (a).

Dasan (like Wagner) also does not teach or suggest step (b) of claim 1. Dasan's "profile" is limited to search (criteria) specifications (col. 5, lines 61-64) for creating a newspaper (col. 2, lines 41-42; col. 1, lines 13-15). This "profile" includes the types of newspaper stories/articles which are of interest to the user (col. 4, lines 46-50). Where does Dasan access a "customer profile value" (from a data store) responsive to "customer identification information" (read from a card with a card reading device) in an automated transaction machine environment? As Dasan does not teach or suggest the recited features, Dasan cannot alleviate the deficiencies of Wagner with regard to recited step (b). It follows that the Office has not established a *prima facie* case of obviousness with regard to recited step (b).

Dasan (like Wagner) further does not teach or suggest step (c). As Dasan does not teach or suggest steps (a) and (b), Dasan cannot teach or suggest generating a web page responsive to "*the at least one customer profile value*" in the manner recited in step (c). Where does Dasan teach or suggest generating a web page in response to a customer profile value that was accessed from a data store in response to customer identification information read from a card with a card

reading device? It follows that the Office has not established a *prima facie* case of obviousness with regard to recited step (c).

Dasan (like Wagner) additionally does not teach or suggest step (d). Step (d) refers back to "*the* at least one web page" of step (c). Where does Dasan teach or suggest displaying a web page to present selectable *transactions* to perform with an automated transaction machine? Nor does Dasan teach or suggest displaying (at an automated transaction machine) a web page that was generated in response to a customer profile value that was accessed from a data store in response to customer identification information read from a card with a card reading device. It follows that the Office has not established a *prima facie* case of obviousness with regard to recited step (d).

Appellants have shown that the references of Wagner in view of Dasan do not link display of a web page to a customer's profile that was accessed from reading a card. Nor do the references teach or suggest accessing a customer's profile from customer identification read from a card, and using the customer's profile to display a web page having selections for using an automated transaction machine to perform transactions. Nor do the references link the web page display of automated transaction machine transaction options to reading customer identification from a card. It follows that the relied upon Wagner and Dasan, taken alone or in combination, do not teach or suggest claim 1 (or any step therein).

For reasons previously discussed, as best understood Lawlor and Simmons have not been applied by the Office against any of the steps of claim 1. It follows that the Office has not established a *prima facie* case of obviousness.

Furthermore, even if Lawlor and Simmons were somehow applied against claim 1 they still cannot alleviate the many admitted and noted deficiencies of Wagner/Dasan as they also do not teach or suggest the recited features, relationships, and steps which are not found in Wagner/Dasan. Lawlor is directed to dedicated telephone-based home banking (col. 7, lines 5-7) that does not require a card. Lawlor actually teaches against using a card (col. 9, line 55 to col. 10, line 2; col. 31, lines 41-61). Simmons is non analogous art. Simmons is directed to network access systems that are used to connect external computers to wide area computer networks. Where does Simmons even teach or suggest a card or a card reader?

The references of Lawlor and Simmons (like Wagner and Dasan) also do not link display of a web page to a customer's profile that was accessed from reading a card. Nor do the references teach or suggest accessing a customer's profile from customer identification read from a card, and using the customer's profile to display a web page to present selectable transactions to perform with an automated transaction machine. Nor do these references link the web page display of automated transaction machine transaction options to reading customer identification from a card. Furthermore, the Action (on page 14, lines 3-5) *admits* that the combined Wagner/Dasan/Lawlor/Simmons do not teach or suggest displaying a web page "including a plurality of selectable transaction options for performing transactions with the automated transaction machine." That is, the Action itself admits that even if all of the references were somehow combined they still would not teach or suggest recited step (d).

It follows that the relied upon Wagner, Dasan, Lawlor, and Simmons references, taken alone or in combination, do not teach or suggest the recited method of claim 1. The Action's

assertions are not based on any evidence in the record. That is, the record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra.

Nor do the references teach or suggest the desirability of the alleged combination. *In re Mills*, supra. Again, the rejection is based on pure hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The rejection lacks the necessary evidence and rationale, and is based on knowledge gleaned only from Appellants' disclosure. There is no teaching, suggestion, or motivation for combining features of the references so as to produce the recited invention.

The Action is also silent with regard to reasonable specificity as to how Wagner could be structurally modified with the alleged secondary teachings to perform the recited method. Appellants have been left to speculate as to how the many alleged features in the large number of secondary references could be implemented in the strict teaching of Wagner. Accordingly, the Action procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

The references do not teach or suggest the recited features, relationships, and steps. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited method. Even if it were somehow possible (which it isn't) for the references to be combined as alleged, the resultant combination still would not have produced the recited method. Appellants respectfully submit that the Office has not established a *prima facie* showing of obviousness. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn.

Claim 2

The references further do not teach or suggest modifying a customer profile value in a data store responsive to operator input to an automated transaction machine. Where do the references permit a customer of an automated transaction machine to modify that customer's profile? As previously discussed, in *Dasan* a "profile" is merely a user-defined search criteria for finding newspaper stories/articles which are of interest to the user. Where does *Dasan* modify a customer profile value in response to a received input to an automated transaction machine? The Office has not established a *prima facie* showing of obviousness.

Claim 3

Claim 3 depends from claim 2/1. Nor do the references teach or suggest modifying a customer profile value in a data store having a remote database in response to operator input to an automated transaction machine. The Action relies on *Wagner* at col. 6, lines 25-55. However, where does *Wagner* modify a customer profile value in a data store having a remote database, especially when the Action admits (on page 6, last paragraph) that *Wagner* does not modify a customer profile value? The Office has not established a *prima facie* showing of obviousness.

Claim 9

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. For reasons already discussed, the Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest reading an account number from a card with a card reading device of an automated transaction machine; accessing a *plurality* of customer profile *values* that correspond to *the* account number; displaying a web page having selectable options for performing a transaction with *the* automated

transaction machine, where at least one of the selectable options is produced responsive to at least one of *the* accessed plural customer profile values; receiving an input corresponding to a selected one of *the* selectable options; and performing a transaction with *the* automated transaction machine based on *the* selected option.

The references, taken alone or in combination, do not link display of a web page to a customer's profile that was accessed from reading a card. Nor do the references teach or suggest accessing a customer's profile from an account number read from a card, and using the customer's profile to display a web page to present selectable transaction options to perform with an automated transaction machine. Nor do the references relate a web page display of automated transaction machine transaction options to reading an account number from a card with the automated transaction machine. Nor do the references teach or suggest performing, with an automated transaction machine, a transaction that was selected from a displayed web page. Again, the Office has not established a *prima facie* showing of obviousness. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 9 should be withdrawn.

Claim 10

Claim 10 depends from claim 9. The references further do not teach or suggest modifying an accessed customer profile value in a data store in response to receiving a selection for performing a transaction with an automated transaction machine. Where do the references permit modification to a customer profile responsive to a selected option input? As previously discussed, in *Dasan* a "profile" is merely a user-defined search criteria for finding newspaper stories/articles which are of interest to the user. Where does *Dasan* modify an accessed customer

profile value in response to selecting a transaction option in a web page at an automated transaction machine? The Office has not established a *prima facie* showing of obviousness.

Claim 13

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. For reasons already discussed, Wagner does not teach or suggest the recited steps. The Action (on page 4) also admits that Wagner does not teach or suggest the recited steps. However, the Action is silent as to where the secondary references teach or suggest the recited features, relationships, and steps.

For reasons already discussed, the references, taken alone or in combination, do not teach or suggest displaying a web page in an automated transaction machine responsive to a customer type value, where the customer type value differentiates between classes of customers with regard to operations available with the automated transaction machine, where a customer profile accessed from a data store includes the customer type value, and where the customer profile corresponds to a customer identification value received with the automated transaction machine.

Where do the references teach or suggest a customer profile that includes the customer type in terms of availability of automated transaction machine operations? Where do the references teach or suggest a customer profile that differentiates between classes of customers with regard to operations *available* with the (same) automated transaction machine? The references do not link a customer's identification at an automated transaction machine to the class of operations available to *that* customer with *that* automated transaction machine. The Office has not established a *prima facie* showing of obviousness. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 13 should be withdrawn.

Claim 21

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. For the many reasons already discussed, Wagner and Dasan, taken alone or in combination, do not teach or suggest the recited method. The Action (on pages 5 and 6) admits that Wagner/Dasan do not teach or suggest "retrieving marketing information"; "selecting a targeted advertisement responsive to the marketing information"; or that a "web page includes the targeted advertisement." As previously discussed, these are not the only features absent in Wagner/Dasan.

Lawlor and Simmons cannot alleviate the admitted and noted deficiencies of Wagner/Dasan as they also do not teach or suggest the recited features, relationships, and steps which are not found in Wagner/Dasan. Lawlor is directed to dedicated telephone-based home banking (col. 7, lines 5-7). Lawlor does not teach or suggest accessing a customer profile responsive to customer identity information *received at an ATM*. Lawlor's home banking does not occur at an ATM. Some would argue that home banking is the antithesis of ATM banking. Even Lawlor teaches that a home banking terminal is "unlike an ATM" (col. 10, lines 30-32). Therefore, Lawlor teaches away from the recited invention.

It follows that Lawlor does not teach or suggest "retrieving marketing information" from a customer profile accessed in response to customer identity information received at an ATM. It further follows that Lawlor does not teach or suggest "selecting a targeted advertisement" responsive to the marketing information (which was retrieved from a customer profile that was accessed in response to customer identity information received at an ATM). Nor does Lawlor teach or suggest displaying a web page *in a browser of an ATM*, especially where the web page

includes the targeted advertisement (which was selected in response to marketing information that was retrieved from a customer profile which was accessed in response to receiving the customer's identity information at *the* ATM). Where does Lawlor even teach or suggest displaying a web page targeted advertisement at an ATM? Where does Lawlor even mention a browser?

Simmons is non analogous art. Simmons (like Lawlor, Dasan, and Wagner) does not teach or suggest displaying a web page targeted advertisement at an ATM. Where does Simmons even mention an ATM? Simmons does not teach or suggest displaying a web page *in* a browser of an *ATM*, especially where the web page includes a targeted advertisement (which was selected in response to marketing information that was retrieved from a customer profile which was accessed in response to receiving the customer's identity information at *the* ATM).

The references of Lawlor and Simmons (like Wagner and Dasan) do not link display of a web page targeted advertisement at an ATM to a customer's profile that was accessed from customer identity information received at *the* ATM.

The references do not teach or suggest the recited features, relationships, and steps. The rejection is based on impermissible hindsight reconstruction of Appellants' claimed invention. Nor do the references teach or suggest the desirability of the combination. *In re Mills*, supra. The references are devoid of any teaching, suggestion, or motivation for combining features of thereof so as to produce the recited invention. It would not have been obvious to one having ordinary skill in the art to have modified Wagner as alleged to have produced the recited method. Even if it were somehow possible (which it isn't) for the references to be combined as alleged, the resultant combination still would not have produced the recited method. The Office has not

established a *prima facie* showing of obviousness. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 21 should be withdrawn.

Claim 25

Appellants' remarks in support of the patentability of claims 1 and 21 are incorporated herein by reference. For reasons previously discussed (including the admissions by the Office), Wagner and Dasan, taken alone or in combination, do not teach or suggest the recited method. Lawlor and Simmons cannot alleviate the admitted and noted deficiencies of Wagner/Dasan as they also do not teach or suggest the recited features, relationships, and steps which are not found in Wagner/Dasan.

As previously discussed, the references (Wagner, Dasan, Lawlor, and Simmons) do not teach or suggest displaying a web page at a currency dispensing ATM through operation of a browser, where the web page respectively corresponds to customer identification information received at *the* ATM. Nor do the references teach or suggest displaying a web page that includes a plurality of banking transaction selections associated with performing banking transactions *with the* ATM, especially where a selection includes a currency withdrawal request. Where do the references teach or suggest displaying at an ATM a web page having a selection for requesting a currency withdrawal with *the* ATM? The references, taken alone or in combination, do not correspond the displaying at an ATM of a web page of banking transaction selections (with a currency withdrawal request being one of the selections) to customer identification information received at *the* ATM.

The references do not teach or suggest the recited features, relationships, and steps. Nor has the Office established a *prima facie* showing of obviousness. Even if it were somehow

possible (which it isn't) for the references to be combined as alleged, the combination still would not have produced the recited method. Thus, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 25 should be withdrawn.

Claim 26

Claim 26 depends from claim 25. The Action is silent regarding any prior art teaching or suggestion of the recited steps. Regardless, the references do not teach or suggest selecting a banking transaction displayed in a web page at an ATM (step c). Nor do the references teach or suggest accessing a markup language document from a data store, where the markup language document includes an instruction to cause operation of a banking transaction function device associated with the selection (step d). It follows that the references cannot teach or suggest step (e), which is responsive to the instruction accessed in step (d). The Office has not established a *prima facie* showing of obviousness.

Claim 27

Claim 27 depends from claim 26/25. The Action is silent regarding any prior art teaching or suggestion of the recited steps.

For reasons already discussed, the references further do not teach or suggest displaying banking transaction selections in a web page at an ATM, especially where the web page was generated in response to a customer profile that was accessed in response to customer identification information read at the ATM. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 28

Claim 28 depends from claim 27/26/25. The Action is silent regarding any prior art teaching or suggestion of the recited features. Where do the references teach or suggest operating an ATM currency dispenser in response to a dispense currency instruction in a markup document accessed via the Internet? The Office has not established a *prima facie* showing of obviousness.

The Claims Are Not Obvious Over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Deaton and Jheeta

Claims 5, 8, 12, 20, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Deaton and Jheeta.

Claim 5

The Action admits (on page 7, last paragraph) that Wagner/Dasan/Lawlor/Simmons do not teach or suggest reading customer identification information from a smart card with a smart card reader device. The Action instead relies on Deaton. However, Deaton does not teach or suggest generating a web page responsive to a customer profile value accessed from a data store responsive to customer identification information read from a smart card. That is, Deaton (like the other references) does not link display of machine transaction options in a web page to customer identification read from a smart card. It follows that the alleged modification of Wagner would not have resulted in use of a smart card reader device in the manner recited.

Claim 5 additionally recites that "customer identification information is read from a smart card". The Action (on page 8) further admits that "Wagner, Dasan, Lawlor et al., Simmons and Deaton et al. disclose(s) the claimed invention except customer identification." The Action's

reliance on Jheeta for allegedly teaching that "authorized transactions are conventionally stored in the customer database that contains customer identification" is moot as claim 5 does not recite these features. The Action does not rely on Jheeta for the admittedly absent feature (in Wagner/Dasan/Lawlor/Simmons/Deaton) of reading "customer identification" from a smart card. Nor does Jheeta teach or suggest the recited features. Hence, the Office has not established a *prima facie* showing of obviousness.

Claim 8

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the recited steps of claim 1. The Action relies on Wagner at col. 6, lines 1-67 as allegedly teaching the recited computer readable media. However, the relied upon section of Wagner does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 1), Wagner does not teach or suggest the recited method of claim 1. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Wagner *alone* does not teach or suggest claim 1. Thus, the allegation that Wagner discloses the computer readable instructions is without merit. Nor has the Office established a *prima facie* showing of obviousness.

Claim 12

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the steps recited in claim 9. The Action relies on Wagner at col. 6, lines 1-67 as

allegedly teaching the recited computer readable media. However, the relied upon section of Wagner does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 9), Wagner does not teach or suggest the recited method of claim 9. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Wagner *alone* does not teach or suggest claim 9. Thus, the allegation that Wagner discloses the computer readable instructions is without merit. Nor has the Office established a *prima facie* showing of obviousness.

Claim 20

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the steps recited in claim 13. The Action relies on Wagner at col. 6, lines 1-67 as allegedly teaching the recited computer readable media. However, the relied upon section of Wagner does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 13), Wagner does not teach or suggest the recited method of claim 13. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Wagner *alone* does not teach or suggest claim 13. Thus, the allegation that Wagner discloses the computer readable instructions is without merit. The Office has not established a *prima facie* showing of obviousness.

Claim 24

The references, taken alone or in combination, further do not teach or suggest computer readable media having computer readable instructions operative to cause at least one computer to carry out the steps recited in claim 21. The Action relies on Wagner at col. 6, lines 1-67 as allegedly teaching the recited computer readable media. However, the relied upon section of Wagner does not teach or suggest computer readable media that is operative to cause the recited method to be performed.

As previously discussed (e.g., claim 21), Wagner does not teach or suggest the recited method of claim 21. Even the Action *admits* (on page 4; and via the obviousness type rejection) that Wagner *alone* does not teach or suggest claim 21. Thus, the allegation that Wagner discloses the computer readable instructions is without merit. The Office has not established a *prima facie* showing of obviousness.

Claim 22 is Not Obvious Over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Jheeta

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Jheeta.

Claim 22 contains an obvious typographical error, as the step should be labeled (f) instead of (e). Authorization for the Office to correct the typographical error is hereby granted.

Claim 22

Claim 22 depends from claim 21. The references, taken alone or in combination, further do not teach or suggest displaying a promotion for a financial institution in a web page at an

ATM to a customer determined not to be a customer of that financial institution. The Action admits (on page 9) that Wagner/Dasan/Lawlor/Simmons do not teach or suggest features of the recited determining step.

Jheeta is directed to an ATM (14) that is operative to dispense to a customer a receipt (18) containing a promotion and a telephone number to call for redeeming the promotion. When the customer calls the telephone number, a telephonic survey (28) is conducted and includes questions (col. 3, lines 39-59) relating to products and services offered by a marketer.

The relied upon sections of Jheeta relate to a *telephone* survey, not to *displaying* a promotion for a financial institution in a *web page* at an ATM. Jheeta has a display (14a), but the messages are printed on a (paper) receipt. Furthermore, claim 22 recites that the financial institution information is determined prior to selection of a targeted advertisement (for display). The references do not teach or suggest the recited features, relationships, and step. The Office has not established a *prima facie* showing of obviousness.

**Claim 4 is Not Obvious Over
Wagner in view of Dasan, Lawlor, and Simmons
and further in view of Akiyama**

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Akiyama.

Claim 4

Claim 4 depends from claim 2/1. The Action (on page 10) admits that Wagner/Dasan/Lawlor/Simmons does not teach or suggest a data store including a smart card. The Action relies on Akiyama as teaching a smart card.

Appellants respectfully submit that the Office does not read the claim as a whole (in light of the features of claims 1 and 2). Where does Akiyama (or any of the references) teach or suggest modifying (claim 2) a customer profile value in a data store that includes a smart card (claim 4), especially where the modification is responsive to an input received from an operator of the automated transaction machine?

As Akiyama cannot alleviate the deficiencies of Wagner/Dasan/Lawlor/Simmons, the references, taken alone or in combination, do not teach or suggest that the recited features, relationships, and steps. The Office has not established a *prima facie* showing of obviousness.

**The Claims Are Not Obvious Over
Wagner in view of Dasan, Lawlor, and Simmons
and further in view of Patterson**

Claims 6-7, 11, 17, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Patterson.

Claim 6

Claim 6 depends from claim 2/1. The Action (at pages 10-11) admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest the recited features. The Action (on page 12) alleges that Patterson discloses "customer profile value and customer type along with option selection." The Appellants respectfully disagree.

Nevertheless, where does Patterson teach or suggest a customer profile *value* that is *representative of a preferred* customer language? Where does Patterson teach or suggest (or even mention) different languages? The Action's assertions are not based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

Where do the references, taken alone or in combination, teach or suggest the ability to generate a web page in a language that corresponds to a customer profile *value*? Where does Patterson relate customer profile value to the language displayed? Furthermore, where do the references, taken alone or in combination, teach or suggest the ability of a customer to change their preferred language by modifying their (customer profile) value via an input? Again, the Office has not established a *prima facie* showing of obviousness.

Claim 7

Claim 7 depends from claim 2/1. The Action (at pages 10-11) admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest the recited features. The Action alleges that Patterson discloses "customer profile value and customer type along with option selection." The Appellants respectfully disagree.

Nevertheless, where does Patterson teach or suggest a customer profile *value* that is *representative* of a fast cash amount? Patterson teaches an ATM that predicts the type of transaction most likely to be requested by a user (col. 1, lines 21-28). However, the evidence of record does not teach or suggest that in Patterson the transaction most likely to be requested was a fast cash amount. It is also unclear how Patterson's type of *transaction* corresponds to the recited fast cash *amount*. The Office's assertion is not based on any evidence in the record and lacks substantial evidence support for the rejection. Nor is the determination of patentability based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

Further, where do the references, taken alone or in combination, teach or suggest the ability of a machine operator to modify a fast cash amount via an input. Also, where do the references, taken alone or in combination, teach or suggest the ability of a customer to change

their fast cash amount by modifying their (customer profile) value via an input? Where do the references teach or suggest these features? Again, the Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Wagner in the manner alleged to have produced the recited invention.

Claim 11

Claim 11 depends from claim 10/9. The Action (on page 11) admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest a customer profile *value* that is representative of a "last withdrawal amount." The Action (on page 12) alleges that Patterson discloses "customer profile value and customer type along with option selection." The Appellants respectfully disagree.

Where does Patterson teach or suggest a customer profile value that is representative of a *last* withdrawal amount? Patterson teaches an ATM that predicts the type of transaction most likely to be requested by a user (col. 1, lines 21-28). However, the evidence of record does not teach or suggest that in Patterson the transaction most likely to be requested was the *last* withdrawal amount. It is also unclear how Patterson's type of *transaction* corresponds to the recited withdrawal *amount*. An assertion not based on any evidence in the record (which is the current situation) lacks substantial evidence support for the rejection. The determination of patentability must be based on evidence of record. *In re Zurko*, supra. *In re Lee*, supra.

Further, where do the references, taken alone or in combination, teach or suggest the ability to generate a web page having a selectable option to dispense the last withdrawal amount? Where do the references teach or suggest modifying the last withdrawal amount via a selection to

a web page option? Where do the references teach or suggest these features? Again, the Office has not established a *prima facie* showing of obviousness.

Claim 17

Claim 17 depends from claim 13. The Action (on page 12) admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest updating a customer profile responsive to received input. That is, the Action admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest recited steps (d) and (e) (contrary to the incorrect listing of the steps as (e) and (f) in the Action). Unheeded notices of this incorrect listing were already pointed out in the Appeal Brief dated March 7, 2005 (at page 38) and the Appeal Brief dated May 12, 2004 (at page 30). The failure of the Office to correct the listing gives the appearance that Appellants' arguments against the rejection were never considered.

The Action relies on "Official notice that it is old and well known in the computer art to get the advantage of providing customers with selectable options that automatically builds the customer's profile in order to present the customer with relevant selectable options upon subsequent ATM use." The Action then alleges that it would have been obvious "to include customer selectable options in which the actual selected option becomes a part of the customers' stored profile."

The Appellants respectfully disagree. The Patent Office is not permitted to rely on unsupported assertions as the basis for rejecting claims (which is the current situation). Appellants previously challenged (e.g., at page 39 of the Appeal Brief dated March 7, 2005; and in the Appeal Brief dated May 12, 2004) the Action's relied upon "Official Notice" assertion on the basis that it is not common knowledge, well known, nor supported by any reference to prior

art. The evidence of record does not teach or suggest the recited features. Where does the prior art evidence of record teach or suggest updating customer profile data responsive to a received input corresponding to a selectable transaction option included in a web page displayed at an automated transaction machine? The determination of patentability must be based on concrete evidence of record. An assertion of basic knowledge and common sense (which is the current situation) not based on any evidence in the record lacks substantial evidence support for the rejection. It is never appropriate (as in the current situation) to rely solely on "Official Notice" as the principal evidence upon which a rejection is based. *In re Zurko*, supra. *In re Lee*, supra. The rejection is based on a mere assertion (i.e., the Official notice), not evidence of record. Thus, the rejection is not legally valid.

The references of record, taken alone or in combination, do not teach or suggest updating customer profile data responsive to a received input corresponding to a selectable transaction option included in a web page displayed at an automated transaction machine. The Office has not established a *prima facie* showing of obviousness.

Appellants note that their previous challenges to this "Official Notice" assertion were not overcome. Even with ample time the Office has not successfully rebutted Appellants' challenges. The Action's failure to present support for the "Official Notice" assertion (especially in response to Appellants' challenges) constitutes Agency Action under the Administrative Procedures Act admitting that the relied upon "Official Notice" assertion does not have support in the prior art. Again, a *prima facie* showing of obviousness has not been established.

Claim 23

Claim 23 depends from claim 21. The Action (on page 12) admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest updating a customer profile responsive to received input corresponding to a web page selection at an ATM. The Action relies on "Official notice that it is old and well known in the computer art to get the advantage of providing customers with selectable options that automatically builds the customer's profile in order to present the customer with relevant selectable options upon subsequent ATM use." The Action then alleges that it would have been obvious "to include customer selectable options in which the actual selected option becomes a part of the customers' stored profile."

The Appellants respectfully disagree. The Patent Office is not permitted to rely on unsupported assertions as the basis for rejecting claims (which is the current situation). Appellants previously challenged (e.g., at page 40 of the Appeal Brief dated March 7, 2005; and in the Appeal Brief dated May 12, 2004) the Action's relied upon "Official Notice" assertion on the basis that it is not supported by any reference to prior art. The evidence of record does not teach or suggest the recited features. Where does the prior art evidence of record teach or suggest updating a customer profile responsive to a received input corresponding to a selectable option included in a targeted advertisement displayed in a web page at an ATM? The determination of patentability must be based on concrete evidence of record. An assertion of basic knowledge and common sense (which is the current situation) not based on any evidence in the record lacks substantial evidence support. It is *never* appropriate (as in the current situation) to rely solely on "Official Notice" as the principal evidence upon which a rejection is based. *In*

re Zurko, supra. *In re Lee*, supra. The rejection is based on a mere assertion (i.e., the Official notice), not evidence of record. Thus, the rejection is not legally valid.

The references of record, taken alone or in combination, do not teach or suggest updating a customer profile responsive to a received input corresponding to a selectable option included in a targeted advertisement displayed in a web page at an ATM. The Office has not established a *prima facie* showing of obviousness.

The Office has not successfully rebutted Appellants' previous challenges to the "Official Notice" assertion. It follows that the Action's failure to present support for the "Official Notice" assertion (especially in response to Appellants' challenge) constitutes Agency Action under the Administrative Procedures Act admitting that the relied upon "Official Notice" assertion does not have support in the prior art. Again, a *prima facie* showing of obviousness has not been established.

**The Claims Are Not Obvious Over
Wagner in view of Dasan, Lawlor, and Simmons
and further in view of Clausing**

Claims 14-15 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, and Simmons and further in view of Clausing.

Claim 14

Claim 14 depends from claim 13. The Action (on page 13) admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest that a customer type value corresponds to a servicer of automated transaction machines. The Action (on page 14) alleges that Clausing

discloses "option selection based on customer profile values that are associated with a specific class of service." The Appellants respectfully disagree.

Nevertheless, where does Clausing teach or suggest a customer type value corresponding to a *servicer* of automated transaction machines. The Office misinterprets the reference as Clausing is directed to having a plurality of customer stations timeshare with a local processor, where the stations are accessible to *customers*. Where does Clausing discuss a machine *servicer*?

The references, taken alone or in combination, do not teach or suggest displaying an automated transaction machine web page that includes a plurality of selectable *servicer* options for *servicing* the machine. Where do the references link machine *servicer* options to web page display at an automated transaction machine? Where do the references even mention a *servicer* of an automated transaction machine? The rejection is based on a mere assertion, not evidence of record to sustain the rejection. *In re Zurko*, supra. *In re Lee*, supra.

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner/Dasan/Lawlor/Simmons with the alleged teaching of Clausing to have produced the recited method.

Claim 15

The Action (on page 14, first paragraph) admits that Wagner/Dasan/Lawlor/Simmons do not teach or suggest that a "customer type value corresponds to a consumer." The Action further admits that these references do not teach or suggest a web page "including a plurality of selectable transaction options for performing transactions with the automated transaction machine."

The Action is silent as to where Clausing teaches or suggests the recited features.

Regardless, the references, taken alone or in combination, do not teach or suggest displaying a web page that includes a plurality of selectable transaction options for performing transactions with the automated transaction machine when the customer type corresponds to a consumer. It would not have been obvious to one having ordinary skill in the art to have modified Wagner/Dasan/Lawlor/Simmons in the manner alleged to have produced the recited method.

Claim 18

Claim 18 depends from claim 13. The Action (on page 14) admits that Wagner/Dasan/Lawlor/Simmons does not teach or suggest the recited features of claim 18. The Action (at page 14, last paragraph) alleges obviousness based on the teaching of Clausing. However, Clausing does not teach or suggest that when a *customer type* value corresponds to a first *class of customer*, the displayed web page includes a first option to perform a first transaction with the automated transaction machine, and when the *customer type* value corresponds to a second *class of customer*, the displayed web page does not include the first option. Where does Clausing (especially in the relied upon sections) or any of the references, taken alone or in combination, teach or suggest the ability to display a web page with a first transaction option to a first class of customer and not display the first transaction option in a web page to a second class of customer?

The references do not teach or suggest the recited method. The Office has not established a *prima facie* showing of obviousness. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Wagner/Dasan/Lawlor/Simmons in the manner alleged to have produced the recited method.

**Claim 16 is Not Obvious Over
Wagner in view of Dasan, Lawlor, Simmons, and Clausing
and further in view of Patterson**

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Patterson.

Claim 16

Claim 16 depends from claim 15/13. The Action does not address the *recited* features of claim 16. The Action (on page 15) refers to steps (e) and (f). However, recited claim 16 recites steps (d) and (e), without a step (f). The steps referenced in the Action appear to correspond to those in claim 23, not claim 16. The Action is silent regarding the recited step of dispensing an amount of cash with a cash dispenser device responsive to the input (in step d).

This issue was previously brought to the attention of the Office numerous times, including Appellants' Appeal Brief (on page 44) filed March 7, 2005; the Appeal Brief (on page 30) filed May 12, 2004; and the Appeal Brief (on page 27) filed November 14, 2003. The failure of the Office to correct the issue gives the appearance that Appellants' Appeal Brief arguments are not being considered.

The references, taken alone or in combination, do not teach or suggest dispensing an amount of cash with a cash dispenser device responsive to receiving an input that corresponds to a selectable transaction option displayed on a web page at an automated transaction machine. The Action admits that Wagner/Dasan/Lawlor/Simmons/Clausing do not teach or suggest the recited features of claim 16.

Patterson is relied upon to teach "option selection based on customer profile". Patterson is not relied upon to teach or suggest dispensing an amount of cash in the manner recited in step

(e). As Patterson has not been shown by the Office to teach or suggest the (admittedly absent) recited features, a *prima facie* showing of obviousness has not been established. Further, Patterson cannot alleviate the admitted deficiencies of Wagner/Dasan/Lawlor/Simmons/Clausing as it does not teach or suggest the recited features which are not found therein.

As noted in at least one previous Appeal Brief, the mention of "Official Notice" (on page 16) is bewildering, as it is not pertinent to the recited claim language. The "Official Notice" appears to correspond to the "Official Notice" presented with regard to claim 23. Nonetheless, the "Official Notice" assertion is again challenged by Appellants.

**Claim 19 is Not Obvious Over
Wagner in view of Dasan, Lawlor, Simmons, and Clausing
and further in view of Martin**

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner in view of Dasan, Lawlor, Simmons, and Clausing and further in view of Martin.

Claim 19

Claim 19 depends from claim 18/13. The Action (on page 17, first paragraph) admits that Wagner/Dasan/Lawlor/Simmons/Clausing do not teach or suggest that "the first transaction corresponds to bill payment". The Action relies on Martin as teaching ATM transactions that permit bill payment. The Action then alleges that it would have been obvious to have modified Wagner/Dasan/Lawlor/Simmons/Clausing to have included using an ATM screen to select bill payment.

The Appellants respectfully disagree. Martin does not teach or suggest that when a customer type value corresponds to a first class of customer (claim 18), a displayed web page

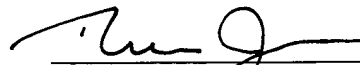
includes an option to pay a bill (claim 19) with the automated transaction machine, and when the customer type value corresponds to a second class of customer (claim 18), the displayed web page does not include the bill pay option. Where does Martin teach or suggest displaying a web page? Where do the references, taken alone or in combination, teach or suggest the ability to display a web page with a bill payment option to a first class of customer *and* display a web page without the bill payment option to a second class of customer?

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner/Dasan/Lawlor/Simmons/Clausing in the manner alleged to have produced the recited method.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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(viii)



CLAIMS APPENDIX

1. A method of operating an automated transaction machine comprising:
 - a) reading customer identification information from a card with a card reading device in operative connection with an automated transaction machine;
 - b) accessing at least one customer profile value from at least one data store, responsive to the customer identification information;
 - c) generating at least one web page responsive to the at least one customer profile value; and
 - d) displaying the at least one web page at the machine through operation of a browser, wherein the at least one web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine.
2. The method according to claim 1, further comprising:
 - e) receiving an input from an operator of the automated transaction machine; and
 - f) modifying the at least one customer profile value in the data store responsive to the input.

3. The method according to claim 2, wherein the data store includes a remote database.
4. The method according to claim 2, wherein the data store includes a smart card.
5. The method according to claim 1, wherein in step (a) the reading device includes a smart card reader device, and wherein the customer identification information is read from a smart card.
6. The method according to claim 2, wherein the customer profile value is representative of the preferred natural language of the customer, wherein the web page is generated in a language that corresponds to the value, wherein the input is representative of a different value for the preferred natural language of the customer.
7. The method according to claim 2, wherein the customer profile value is representative of a fast cash amount, wherein the web page includes a selectable option which corresponds to having the automated transaction machine dispense an amount of cash that is equal to the fast cash amount, wherein step (f) includes modifying the fast cash amount.
8. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 1.

9. A method comprising:

- a) reading an account number from a card with a card reading device of an automated transaction machine;
- b) accessing a plurality of customer profile values that correspond to the account number;
- c) displaying a web page in a browser with the automated transaction machine, wherein the web page includes a plurality of selectable options for performing a transaction with the automated transaction machine, wherein at least one of the selectable options is produced responsive to at least one of the accessed customer profile values;
- d) receiving an input that corresponds to a selected one of the selectable options with an input device; and
- e) performing the transaction with the automated transaction machine responsive to the selected one of the selectable options.

10. The method according to claim 9, further comprising:
 - f) modifying at least one of the accessed customer profile values in the data store responsive to the selected option.
11. The method according to claim 10, wherein the customer profile values include a last withdrawal amount representative of a previously withdrawn amount of cash, wherein one of the selectable options corresponds to a dispensing of an amount of cash equal to the last withdrawal amount, wherein step (e) includes dispensing of a selected amount of cash with a cash dispenser device, and wherein step (f) includes modifying the last withdrawal amount with a value that corresponds to the selected amount of cash.
12. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 9.
13. A method comprising:
 - a) receiving at least one customer identification value with an automated transaction machine;

- b) accessing a customer profile from a data store, wherein the customer profile corresponds to the customer identification value, wherein the customer profile includes a customer type value, wherein a customer type value differentiates between classes of customers with regard to operations available with the automated transaction machine; and
 - c) displaying a web page in a browser of the automated transaction machine, wherein the web page is loaded responsive to the customer type value.
14. The method according to claim 13, wherein when the customer type value corresponds to a servicer of automated transaction machines, the web page includes a plurality of selectable servicer options for servicing the automated transaction machine.
15. The method according to claim 13, wherein when the customer type value corresponds to a consumer, the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine.
16. The method according to claim 15, further comprising:
- d) receiving an input that corresponds to one of the selectable transaction options; and

e) dispensing an amount of cash with a cash dispenser device responsive to the input.

17. The method according to claim 13, wherein the web page includes a plurality of selectable transaction options for performing transactions with the automated transaction machine, and wherein the method further comprises:

d) receiving an input that corresponds to one of the selectable transaction options;
and

e) updating the customer profile data responsive to the input.

18. The method according to claim 13

wherein when the customer type value corresponds to a first class of customer, the web page includes a first option to perform a first transaction with the automated transaction machine,

wherein when the customer type corresponds to a second class of customer, the web page does not include the first option.

19. The method according to claim 18, wherein the first transaction corresponds to bill payment.

20. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 13.
21. A method comprising:
- a) receiving a customer identity information at an ATM, wherein the ATM includes a cash dispenser operative to dispense cash;
 - b) accessing a customer profile responsive to the customer identity information;
 - c) retrieving marketing information from the customer profile;
 - d) selecting a targeted advertisement responsive to the marketing information; and
 - e) displaying a web page in a browser of the ATM, wherein the web page includes the targeted advertisement.
22. The method according to claim 21, further comprising prior to step (d):
- e) determining if the consumer is a customer associated with a financial institution, wherein if the consumer is determined not to be a customer of the financial

institution, the targeted advertisement includes a promotion for the financial institution.

23. The method according to claim 21, wherein the targeted advertisement includes at least one selectable option, wherein the method further comprises:

(f) receiving an input from the consumer that corresponds to the selectable option; and

(g) updating the customer profile responsive to the input.

24. Computer readable media having computer readable instructions embodied thereon, the computer readable instructions operative to cause at least one computer to carry out the method steps recited in claim 21.

25. A method comprising:

(a) receiving customer identification information with an ATM, wherein the ATM includes at least one banking transaction function device, wherein the at least one banking transaction function device includes a currency dispenser operative to dispense currency,

- (b) displaying at least one web page at the ATM through operation of at least one browser, wherein the at least one web page respectively corresponds to the received customer identification information, wherein the at least one web page includes a plurality of banking transaction selections associated with performing banking transactions with the ATM, and wherein at least one of the selections includes a currency withdrawal request.

26. The method according to claim 25 and further comprising:

- (c) receiving an input corresponding to a selection with the at least one input device of the ATM,
- (d) responsive to step (c), accessing at least one markup language document from at least one data store, wherein the at least one markup language document includes at least one instruction adapted to cause operation of at least one banking transaction function device associated with carrying out a banking transaction function corresponding to the selection,
- (e) responsive to the at least one instruction accessed in step (d), operating the at least one banking transaction function device in carrying out the banking transaction function.

27. The method according to claim 26 wherein step (a) includes reading customer identification information with a reading device in operative connection with the ATM, and further comprising:

(f) responsive to the customer identification information read in step (a),
accessing at least one customer profile from at least one data store,

(g) generating at least one web page responsive to the at least one customer profile,

wherein step (b) includes displaying the at least one web page generated in step (g).

28. The method according to claim 27 wherein in step (d) the at least one markup document is accessed via the Internet and includes a currency dispense instruction operative to cause operation of the currency dispenser,

wherein step (e) includes operating the currency dispenser to dispense currency responsive to the currency dispense instruction.

(ix)

EVIDENCE APPENDIX

(None)

(x)

RELATED PROCEEDINGS APPENDIX

(None)